

### **Amendments To The Drawings**

The enclosed sheet of formal drawings contains Figures 11 to 15. The formal drawing containing Figures 11 to 15 is also submitted under separate cover.

## **REMARKS/ARGUMENTS**

Claims 1 to 3, 5, 10, 11, 14 and 15 are pending. Claim 4 was earlier cancelled. Claims 6 to 9, 12 and 13 have been withdrawn. Claims 1, 2 and 5 have been amended.

The Office Action stated: that applicant's election of species 1, Claims 1 to 3, 5, 10 and 11, 14 and 15, in the reply filed on July 10, 2006 is acknowledged; Claims 6, 7, 12 and 13, directed to non-elected species, have been withdrawn from consideration; that Claims 8 and 9, amended to depend solely on non-elected Claim 7, are also withdrawn; and that, because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse [MPEP § 818.03(a)]. Applicant reserves the right to file a continuing, continuation and/or divisional application on the non-elected species, if a generic claim is not allowed.

The Office Action stated: that the proposed drawings were received on July 10, 2006; that the proposed drawings are approved; and that new formal drawings of Figures 11 to 15 will be necessary. The sheet of formal drawings of Figures 11 to 15 is enclosed.

The Office Action stated that the following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 to 5, 10, 11, 14 and 15 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action stated: that in Claim 1, line 9, "remaining portion" should be preceded by an article to be grammatical; and see also Claim 5, line 8, for the same indefiniteness. Both claims have been amended in such manner.

The Office Action stated that in Claim 2, line 4, "a cover film" is indefinite, as the same cover film has been antecedently defined in Claim 1, lines 6 and 9, and should be so indicated. Antecedent basis has been supplied.

This rejection should be withdrawn.

Support for amending Claim 1 to recite that there are not any holes in front wall (12) and back wall (14) is in Figures 2 to 5. An object of the invention is to have a separate film attached to one of the outer wall surfaces of package that is peelable away except for one hinged end so as to see printing on the inner surface of the separate film and the outer surface of the wall. A hole in the wall under the peelable section would expose package content and allow it to fall out thereby destroying a main feature of applicant's claimed invention.

Webster's Ninth New Collegiate Dictionary defines a hole as being "an opening through something".

The Office Action stated that the following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the

differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 3, 5, 10 and 11 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Muir et al. (U.S. Patent No. 6,767,604) in view of Brunner et al. (U.S. Patent No. 6,041,929). Applicant traverses this rejection.

This and the other obviousness rejections in the Office Action are faulty because the Examiner has not factually established the ordinary level of the skill in the art as required by the Supreme Court's Graham decision and by Patent Office policy. The Examiner has not factually established in the record a prima facie showing of obviousness [and cannot because Section 103(a), the Graham decision requirements and Patent Office policy have not been followed].

The Office Action stated that Muir et al. discloses a packaging bag (Figures 1 and 4) with a front wall and a rear wall in which the front wall and rear wall are bonded together along a peripheral edge (at the shown top and bottom edges 22 and 24), at least one of the front wall and rear wall bonded to a cover film (12) which is printed on one or both sides, substantially the entire area of the cover film being bonded to and peelable from the at least one of the front wall and rear wall, and a remaining portion of the cover film (38) is permanently bonded to the packaging film in an edge area. Applicants traverse this statement. Muir et al. requires that a (dispensing) hole be located in the film/wall under the label (film). This opening in the wall would destroy applicant's

invention. Applicant seeks to have a peelable film that hinges out from the outer surface of front/back wall so that printing can be located on the outer surface of the front/back wall and on the inner and outer surfaces of the hinged peelable film.

A hole in the wall under the peelable film would mean exposing the package contents to the air and to falling out of the package. Muir et al. is not a very relevant prior art reference. One ordinarily skilled in the art would eliminate Muir et al. as a relevant reference in the search for applicant's claimed invention.

The Office Action stated that Brunner et al. discloses at least one of the front wall and rear wall of a packaging bag printed on the outside of the bag (at 14). The wall of Brunner et al. is made up of several layers adhesively attached to one another. The peelable portion 16 is actually a part of the wall that is cut on three sides as to form a hingeable portion 16, however hingeable portion is not a film separate from the outer layer of the wall. Brunner et al. directs away from applicant's claimed invention.

The Examiner has not factually provided in the record the motivation to combine the two rejection references. Even if they are combined, the result is not applicant's claimed invention.

The Office Action stated that to modify Muir et al. employing printing on the walls of the bag would have been obvious in view of Brunner et al. in order to identify the contents as suggested by Brunner et al. The result of such combination of references does not result in applicant's claimed invention.

The Office Action stated that, as to Claims 2 and 10, Muir et al. discloses the front wall of a first packaging film (21) and the rear wall of a second

packaging film (23), at least one of the packaging films bonded to the cover film (12). The result is not applicant's claimed invention.

The Office Action stated that, as to Claims 3 and 11, Muir et al. also discloses the front wall and the rear wall being of the same packaging film (see column 3, lines 46 to 61). The result is not applicant's claimed invention.

This rejection should be withdrawn.

Claims 14 and 15 have been rejection under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 5 in the previous paragraph immediately above, and further in view of Scott et al. (U.S. Patent No. 6,113,271). Applicants traverse this rejection.

The Office Action stated that Scott et al. discloses employing permanent adhesive (see column 4, lines 3 to 11). Scott et al. does not cure the defects of the combination of Muir et al. and Brunner et al. in the quest for applicant's claimed invention.

Scott teaches away from applicant's claimed invention.

The Office Action stated that to modify the permanent bond of Muir et al. employing permanent adhesive would have been an obvious substitution of equivalent permanent bond-defining means, given the disclosures of Muir et al. and Scott et al. Applicant's invention as a whole is not suggested or achieved by the rejection references, singularly or in combination.

The Office Action stated that, as to Claim 15, since the prior art combination discloses printing in general, and applicant discloses register printing to be known in the field, to employ the commonly known register printing

process would have been obvious to one of ordinary skill in the art. The rejection combination does not result in applicant's claimed invention.

This rejection should be withdrawn.

Claims 1, 5, 14 and 15 have been rejection under 35 U.S.C. 103(a) as being unpatentable over Scott et al. (U.S. Patent No. 6,113,271) in view of Brunner et al. (U.S. Patent No. 6,041,929). Applicant traverse this rejection.

All of the teachings of the prior art of record must be considered under Section 103(a).

The Office Action stated that Scott et al. discloses a packaging bag (Figure 1) with a front wall and a rear wall in which the front wall and rear wall are bonded together along a peripheral edge (at the shown lateral edges), at least one of the front wall and rear wall bonded to a cover film (18) which is printed on one or both sides, substantially the entire area of the cover film being bonded to and peelable from at least one of the front wall and rear wall, and a remaining portion (20) of the cover film is permanently bonded to the packaging film in an edge area. Applicant traverses this statement because Scott et al. teaches away from applicant's claimed invention and would destroy it. The resealable label flap of Scott et al. is used to cover up a hole in the wall of the package that allows access to the package contents. So Scott et al. in combination with Brunner et al. does not result in applicant's claimed invention.

The Office Action stated that Brunner et al. discloses at least one of the front wall and rear wall of a packaging bag printed on the outside of the bag (at 14). Brunner et al. does not cure the defects of Scott et al. in the search for applicant's claimed invention.

The Examiner has not provided a convincing showing of motivation to combine Scott et al. and Brunner et al.

The Office Action stated that to modify Scott et al. employing printing on the walls of the bag would have been obvious in view of Brunner et al. in order to identify the contents, as by suggested by Brunner et al. The result is not applicant's claimed invention.

The Office Action stated as to Claim 14, Scott et al. disclose employing permanent adhesive (see column 4, lines 3 to 11). The result is not applicant's claimed invention.

The Office Action stated as to Claim 15, since the prior art combination discloses printing in general, and application discloses register printing to be known in the field, to employ the commonly known register printing process would have been obvious to one of ordinary skill in the art and would fail to define any new and unexpected result by its employment. Applicants traverse this statement. The Examiner has not factually determined in the record the level of ordinary skill in the art, so the Examiner has no basis for stating what would be obvious to one ordinarily skilled in the art.

This rejection should be withdrawn.

Claims 1, 2, 5, 10, 14 and 15 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Counts et al. (U.S. Patent No. 5,341,930) in view of Scott et al. Applicants traverses this rejection.

In the prior Office Action the Examiner stated that Counts discloses that at least one edge area of the cover film of Counts is permanently bonded. The

Examiner now admits that one edge area of the cover film of Counts et al. is not permanently bonded.

The prior Office Action stated that Counts et al. discloses a packaging bag (10) with a front wall and a rear wall in which the front wall and the rear wall are bonded together along a peripheral edge (edges of 12 and 14) and at least one of the front wall and the rear wall is printed on the outside of the bag (20), at least one of the front wall and the rear wall is bonded to a cover film (16) which is printed on one or both sides, substantially the entire area of the cover film being bonded to and peelable from the at least one of the front wall and the rear wall. The Examiner incorrectly asserted that at one edge area of the cover film of Counts et al. is permanently bonded.

The prior Office Action stated that, as to Claims 2 and 4, Counts et al. discloses that the front wall of a first packaging film (14) and the rear wall of a second packaging film (12), at least one of the packaging films bonded to a cover film (16), the cover film being permanently bonded at one edge area (see column 6, lines 39 to 47). Applicant traversed this statement as being clearly incorrect and apparently based on a misreading of Counts et al. by the Examiner.

Counts et al. is not a relevant reference since it requires complete removal of outer sheet 16 to uncover the printing on middle sheet 14. To leave special advertising outer sheet 16 permanently hanging from the package would destroy its usefulness as being readily convertible to market goods under general nature advertising on middle sheet 14.

Cover film 16 is only disclosed by Counts et al. as being completely removable (peelable) from side wall 14 of Counts et al.'s package 10. Counts et al. states:

"Accordingly, it is among the objects of the present invention to provide a package for retail goods which has a selectively separable portion and a method for producing the package; the separable portion being of a decorative overlay nature for carrying specialty information, as for example, related to a certain holiday or sporting event, and being capable of facile removal from the package as a whole without destroying the useful integrity of the package. The new separable package is intended to be provided with generic or standard product information or advertising on the package proper which may optionally be hidden, entirely or in part, beneath the separable portion so that when that separable or decorative overlay portion is removed, the package is fully functional for containment of the goods without reference to any particular event, holiday, etc." [Emphasis Supplied] [Col. 2, line 56, to col. 3, line 4]

"It is a further object of the present invention having the aforementioned features that the package be of simple, inexpensive construction and be capable of being easily manufactured with conventional automated equipment, as well as being formed after special treatment of the material of the package so that the separable portion may be simply yet properly and quickly removed by an individual having little or no training, while the front and back panels of the soft package remain

securely connected to each other." [Emphasis Supplied] [Col. 3, lines 48 to 52]

"An outermost one of the plurality of layered sheets is adapted for quick, facile removal from the remainder of the plurality of layered sheets without disrupting the containment function of the package, thereby altering the information outwardly displayed on the package." [Emphasis Supplied] [Col. 3, lines 48 to 50]

"The present invention is also, briefly, a package for containing goods and having an overlay portion which is separable therefrom without disruption of the containment function of the package. The package includes, first, second and third flexible sheets each having a plurality of edges and being arranged in registered, layered fashion.

\* \* \*

At least two of the plurality of edges of the third flexible sheet are releasably sealed to at least two corresponding edges of the plurality of edges of the second flexible sheet, to thereby provide for removal of the third flexible sheet from the package without causing inadvertent separation of the second flexible sheet from the first flexible sheet."

[Emphasis Supplied] [Col. 3, line 53, to Col. 4, line 6]

"In ultimate application, the retailer may effectively have at least double use of a particular package of goods when using the new separable package. For example, holiday baseball card treats C may be provided on the shelves in separable package 10 until the particular holiday, for example, Halloween, is past. At that point, the retailer may

have an employee quickly modify the packages for general sales purposes, as illustrated for example in FIG. 4, by gripping a package 10 with a right hand R positioned adjacent common sealed edge 28 and gripping top sheet 16 adjacent end edge 16d as by a left had L and peeling the same way from middle sheet 14 to leave package 10', as shown in FIG. 5 without top sheet 16. Thus the generic or "everyday" message, such as that shown and indicated at 20 will remain on the front of package 10' which is left intact, as is essential in regard to containment of goods C." [Emphasis Supplied] [Col. 12, line 56, to col. 13, line 4]

"... an outermost one of said plurality of layered sheets is adapted for quick, facile removal from the remainder of said plurality of layered sheets without disrupting the containment function of said package, to thereby provide a means of altering the information outwardly displayed on said package, wherein said outermost layered sheet which is adapted for quick, facile removal is provided on the exterior surface thereof with information of a special nature and a layered sheet which is immediately adjacent thereto is provided on the exterior surface thereof with information of a general nature which is hidden from view by said outermost layered sheet, so that removal thereof...." [Emphasis Supplied] [Claim 1, lines 18 to 32]

"6. A package for containing goods and having an overlay portion which is separable therefrom without disruption of the containment function of said package..., at least two of the plurality of edges of said third flexible sheet being releasably sealed to at least two corresponding

edges of said plurality of edges of said second flexible sheet, to thereby provide a means for removal of said third flexible sheet from said package without causing inadvertent separation of said second flexible sheet from said first flexible sheet,..." [Emphasis Supplied]

"This invention relates, in general, to packages for marketing retail goods, and, more specifically, to a flexible package having a detachable decorative overlay portion which is made separable to allow the retailer to provide specialized marketing information which is removable from the body of the package so as to extend the full price marketing life of the particular packaged goods." [Emphasis Supplied] [Col. 1, lines 11 to 18]

"The package has at least three layered sheets of flexible material, the outermost sheet being quickly and easily removable from the remainder of the package without disruption thereof." [Emphasis supplied] [Abstract, lines 3 to 7]

"There is no prior art relative to a retail package for marketing goods specifically in relation to a certain season or event and having a decorative overlay portion which has been applied in careful registration to the front of the package, which portion may be removed to leave the package intact and allow the continued sale of the goods therein without having to reduce the price after the culmination of the special event or season." [Emphasis Supplied] [Col. 2, lines 48 to 55]

Counts et al. directs away from permanently bonding at least one edge area of its cover film because doing so would destroy the invention of Counts et al. The insertion of Scotts et al. into Counts et al. would not cure the defects of

Counts et al. in the search for applicant's claimed invention, but instead would destroy the Counts et al. invention. One ordinarily skilled in the art, accordingly, does not have the necessary motivation to combine Counts et al. and Scott et al. in the manner incorrectly attempted by the Examiner in the quest for applicant's claimed invention. The Examiner has used forbidden hindsight.

Furthermore, Scott et al. requires a hole in the package wall under the resealable label flap. Hence, the use of Scott et al. would destroy applicant's claimed invention.

The Office Action stated that Counts et al. disclose a packaging bag (Figures 1 and 2) with a front wall (14) and a rear wall (12) in which the front wall and rear wall are bonded together along a peripheral edge (column 6, lines 39 to 47), at least one of the front wall and rear wall is bonded to a cover film (16) which is printed on one or both sides, substantially the entire area of the cover film being bonded to and peelable from the at least one of the front wall and rear wall, and at least one of the front wall and rear wall of the packaging bag printed on the outside of the bag (at 20).

The Office Action stated that Scott et al. discloses a remaining portion (20) of a cover film permanently bonded to a packaging bag in an edge area. This does not result in applicant's claimed invention.

The Office Action stated that to modify the packaging bag of Counts et al. employing the permanent seal teaching of Scott et al. would have been obvious in order to permanently retain the cover film with the bag, as suggested by Scott et al. Obvious to whom? This statement does not meet the requirements of Section 103(a).

The Office Action stated that, as to Claim 2, discloses a first packaging film (14), a second packaging film (12) and a cover film (16). Applicant's claim is unobvious.

The Office Action stated that, as to Claim 10, Counts et al. discloses bonding of the cover film in an edge area. Applicant's claim is unobvious.

The Office Action stated that, as to Claim 14, Scott et al. further disclose employing permanent adhesive (see column 4, lines 3 to 11). Applicant's claim is unobvious.

The Office Action stated that, as to Claim 15, since the prior art combination discloses printing in general, and application discloses register printing to be known in the field, to employ the commonly known register printing process would have been obvious to one of ordinary skill in the art and would fail to define any new and unexpected result by its employment. Applicant traverses this statement. The Examiner has no basis in the record for stating what be obvious to one ordinarily skilled in the art.

This rejection should be withdrawn.

The Office Action stated that applicant's arguments with respect to Claims 1 to 3, 5, 10, 11, 14 and 15 have been considered but are moot in view of the new grounds of rejection. The new rejections also fail.

The Office Action stated that this Office Action is made non-final in view of the new grounds of rejection.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

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## **APPENDIX**

The sheet of formal drawing containing Figures 11 to 15 follows on a separate sheet: